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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/694,883	10/29/2003	Nobuyuki Akai	OGA-208-USAP	4096
28892	7590	08/30/2005	EXAMINER	
SNIDER & ASSOCIATES P. O. BOX 27613 WASHINGTON, DC 20038-7613			SMITH, PHILIP ROBERT	
			ART UNIT	PAPER NUMBER
			3739	

DATE MAILED: 08/30/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

SP

Office Action Summary	Application No. 10/694,883	Applicant(s) AKAI, NOBUYUKI	
	Examiner Philip R. Smith	Art Unit 3739	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 August 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3,4 and 6-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3,4 and 6-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Drawings

- [01] The objections to the drawings with regard to the claimed "sheath" and "metal frame" are withdrawn. Applicant has correctly points out that the "sheath" and "metal frame" are described in the specification and indicated in the drawings.
- [02] The objection to the drawings with regard to the claimed "angle ring" is maintained. Applicant correctly points out that the term "appears at paragraph [0018], line 2," but fails to show that the angle ring appears in the drawings. Applicant states that the "angle ring" composes the "ring-like metal member," the latter of which is indicated in the drawings. But the "angle ring" itself is not explicitly indicated, nor described in such a way as to imply its indication.

Claim Objections

- [03] The term "patent-side" in claim 4 is presumed to be "patient-side." Appropriate correction is required.

Claim Rejections - 35 USC § 112, Paragraph One

- [04] The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
- [05] Claims 1, 3-4 & 6-8 are rejected under 35 U.S.C. §112 as failing to comply with the written description requirement.
- [06] The indefinite term "processor device housing ground processor device" has been amended to overcome the issues raised formerly.

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[07] The indefinite term "angle ring" remains in noncompliance with the written description requirement. As stated in the Office action of 5/4/2005, the terminology lacks a written description except to assert that it composes the "ring-like metal member"; further, the "angle ring" is not indicated in the drawings. Applicant states in the correspondence of 8/3/2005 that "the above angle ring is a part of the insertion section and is the one that is connected to the ring like metal member so as to bend the leading end of the endoscope." The Office action of 5/4/05 had taken into account that the questionable structure was "a part of the insertion section"; it was also determined that the questionable structure composed the "ring like metal member" rather than "connected to" it. Further, there is no basis in the specification for the assertion that the structure in question enabled the bending of the endoscope, nor even that the endoscope was capable of bending. The rejection under 35 U.S.C. §112 is therefore maintained.

Claim Rejections - 35 USC § 102

[08] The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

[09] Claims 1, 3-4 & 6-8 are rejected under 35 U.S.C. §102 as being anticipated by Tsuji et al (6,319,197).

[10] Claims 1, 3-4 & 6 are rejected for the reasons set forth in the Office action of 5/4/2005.

[11] With regard to claim 7: The static electricity suppressing part disclosed by Tsuji

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("capacitor C2," as cited in Office action of 5/4/2005) is an air gap.

- [12] With regard to claim 8: The static electricity suppressing part disclosed by Tsuji ("lead wires to a lug 85," as cited in Office action of 5/4/2005) is a surge absorber.

Response to Arguments

- [13] Applicant's arguments filed 8/3/2005 have been fully considered but they are not persuasive.

- [14] Applicant contends that a capacitor as disclosed by Tsuji could not provide static electricity suppression. This is not persuasive. Firstly, by the Applicant's own admission, the static electricity suppressing part utilizes "a surge absorber or air gap" [0013]. All capacitors utilize a gap of some sort, the gap characterized in that it consists of non-conductive or semi-conductive material. To a skilled artisan, capacitors are defined by their capacitance, not by the specific constituent which characterizes the inherent gap. Capacitances of all varieties, including those characterizes by an "air gap," are equivalent for the purposes of skilled endoscopists. Secondly, Applicant states that "a static charge is a direct voltage, and not an alternating voltage." This is a mischaracterization in that a static charge is a constant voltage *while it is static*; the Application is clearly concerned with static electricity that has been *discharged*. Upon its discharge, static electricity is recognized by a capacitor (or air gap) as a high frequency signal, which, in the case of Tsuji, is passed to ground.

- [15] Applicant further contends that the "shielding cover lines 84a, 84b, and 84c"

disclosed by Tsuji "are not the sheath metal members of the invention of claims 1 and [4] as now amended." On the contrary, original claims 2 and 5 approximate amended claims 1 and 4, respectively, and the rejections are maintained for the reasons set forth in the Office action of 5/4/05: the "shielding cover lines" represent the ends of a ring like metal member in a cable section, which is electrically connected to "individual shield cover wires of the transmission lines 21a, 21b," which extend to the tip of the insertion section. These "individual shield cover wires" extend from a cable section, where they anticipate a ring like metal member, through an operation section, where they anticipate a metal member comprising a metal frame, into the insertion portion, where they anticipate a ring like metal member.

[16] Applicant further contends that "[Tsuji] is a noise-control measure and not a static-electricity-control measure." First, it is noted that an anticipatory reference need not anticipate the intention of the inventor, but only that it anticipate the claimed structures so as to be capable of the same function. Second, it is noted that static-electricity may be considered noise.

[17] Applicant further contends that "there is no direct wire connecting the shields of any input from the cable to (35) [ground of the secondary circuit]." (Presumably, this argument refers to the rejection of claim 1, wherein a static-electricity-suppressing part is provided between the sheath metal member and the processor device housing ground.) As noted above, the Office considers a capacitor to be a static electricity suppressing part to the degree that discharged static electricity

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has high frequency components. It is maintained here that discharged static electricity, characterizes by a flood of charge resulting in a sudden voltage boost, has significant high frequency components which are relieved by a capacitor placed in a path to ground.

[18] Applicant contends that "the purpose of [Tsuji] is to provide isolation, not static electricity suppression. If static electricity suppression were to be provided, [Tsuji] would connect to a ground of circuit portion (35) [ground of the secondary circuit]." As noted earlier, intended use is not a patentable distinction from an anticipatory reference; nor is the intended use necessarily distinct. Secondly, with regard to high frequencies, the capacitor approximates a short circuit. Therefore, the capacitor provides a common ground between (30) and (35) with respect to high frequencies while allowing for a floating ground between isolated systems with respect to DC.

[19] In summary, the patient circuit and secondary circuit have a common ground with respect to discharged static electricity, i.e. high frequencies.

Conclusion

[20] Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

[21] A shortened statutory period for reply to this final action is set to expire THREE

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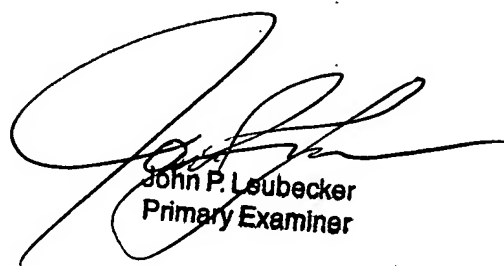
MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

- [22] Any inquiry concerning this communication or earlier communications from the examiner should be directed to Philip R. Smith whose telephone number is (571) 272 6087 and whose email address is philip.smith@uspto.gov. The examiner can normally be reached between 9:00am and 5:00pm.
- [23] If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda Dvorak can be reached on (571) 272 4764.
- [24] Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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[25] prs


John P. Leubecker
Primary Examiner